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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK
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ARISTA RECORDS LLS, et al.,

Plaintiffs,

-against-

LIME GROUP LLC, et al.,

Defendants.
--X

06 Civ. 5936 (KMW)(DF)

ORDER

DEBRA FREEMAN, United States Magistrate Judge:

Currently before the Court are four applications by Defendants to enforce subpoenas served by Defendants on certain licensees of Plaintiffs, specifically, iMesh, Inc. and its subsidiary, MusicLab, LLC (together, "iMesh"), MySpace, Inc. ("MySpace"), Google, Inc. ("Google"), and Yahoo! Inc. ("Yahoo!") (collectively, the "Licensees").[1] The Licensees separately opposed. iMesh and MySpace also moved for sanctions, contending, *inter alia,* that Defendants failed to engage in adequate good faith conference before seeking enforcement and, with respect to iMesh, that the subpoena is duplicative of two prior subpoenas served on iMesh by Defendants earlier in the case. Google moved to have Defendants bear the cost of any production of custodial documents ordered by the Court. Having considered Defendants' and the Licensees' submissions, and for the reasons discussed below, the motions for sanctions made by iMesh and MySpace are denied; Google's motion to shift costs is denied; and Defendants' applications are granted in part and denied in part.

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[1] Defendants' application to enforce the subpoena to MySpace was transferred to this Court from the United States District Court for the Central District of California. Amazon.com, Inc., which is apparently defending a similar application by Defendants to enforce a subpoena currently pending in the U.S. District Court for the Western District of Washington, also joined in one of the submissions to this Court by certain of the Licensees.

DISCUSSION

I. ADEQUACY OF GOOD FAITH CONFERENCE

As a preliminary matter, certain of the Licensees contend that Defendants failed to properly engage in sufficient good-faith conference prior to seeking relief from the Court. Although, based on the correspondence, there is some basis for these Licensees' position that they were willing to continue conferring with Defendants, the Court is persuaded that Defendants' efforts to resolve their disputes with the Licensees were sufficient, in light of the expedited nature of discovery in this case and the fact that the disputes have not been resolved since Defendants sought relief from the Court over a month ago. Accordingly, the Court will consider the motions before it, and denies any application for sanctions based on a lack of good faith conference.

II. EXTENT TO WHICH SUBPOENAS SHOULD BE ENFORCED

Through the Subpoenas, Defendants essentially seek three categories of documents from the Licensees:

(1) copies of license agreements between the Plaintiffs and the Licensees;

(2) reports of payments made by the Licensees to Plaintiffs pursuant to such license agreements; and

(3) the Licensees' communications (both internal and with Plaintiffs) relating to such license agreements and/or to LimeWire.

On more than one occasion in this case, the Court has held that, at least to some extent, these types of documents are relevant to Plaintiffs' damages claims. (*See* Order, dated Oct. 15, 2010 (Dkt. 329); Order, dated Nov. 2, 2010 (Dkt. 339); Opinion and Order, dated Nov. 19, 2010 (Dkt. 363).) Indeed, by Order dated November 23, 2010, the Court ordered another of Plaintiffs' licensees, VEVO, LLC ("VEVO"), to produce copies of their license agreements, certain payment reports, and at least certain communications relating to the licenses in question and/or to LimeWire. (*See* Order, dated Nov. 23, 2010 (Dkt. 367)).

Subsequent to the Court's issuance of its Order regarding VEVO, however, Plaintiffs themselves produced a significant number of documents in the three categories at issue. Defendants contend that, notwithstanding Plaintiffs' production, they are still entitled to seek similar documents from the Licensees.[2] Defendants argue that the Licensees might produce some documents that were not produced by Plaintiffs because, *inter alia*, Plaintiffs and the Licensees could have different email retention policies and/or follow a different review and production protocol. Defendants note that the requested documents are not a well-defined set, such that complete production can be verified, and point to some evidence that productions by other non-party licensees have not been coextensive with Plaintiffs' production to date. Defendants also suggest that, as the Court previously ordered VEVO to produce documents in response to the same type of subpoena, the other Licensees should at least be directed to respond to that same extent.

For their part, the Licensees argue that Defendants' mere speculation that new documents may be produced is not sufficient to outweigh the burden of production. Further, quoting language from this Court's earlier opinion requiring Plaintiffs to produce similar documents, the Licensees argue that the documents sought are only of "tenuous" relevance to this action. (*See, e.g.*, Letter to the Court from Matthew D. Ingber, Esq., dated Jan. 21, 2011, at 2 (quoting Opinion and Order, dated Nov. 6, 2010 (Dkt. 363), at 6).) The Licensees also argue that, as non-parties, their own internal communications would not be relevant to any issues in this case, given that, at most, it is the *parties'* conduct and attitude that may be considered in calculating Plaintiffs' statutory damages.

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[2] It appears that some of the Licensees have already produced documents from one or more of these categories.

As to the Licensees' "burden" argument, the Court notes that, except for MySpace (which has submitted an affidavit detailing the potential expense of producing the requested documents), the Licensees make only generalized and unsupported burden objections, relating to the period of time to be searched and the need for privilege review. Nonetheless, the Court agrees that, where it is likely that particular documents have already been produced by a party, it would be inappropriate to require non-parties to shoulder the burden of making an identical production. Here, Defendants have offered the Court no reason to believe that the license agreements and reports of payments under those agreements that have been produced by Plaintiffs, as licensors, would be any different from the agreements and payment reports that would be produced by the Licensees. Given the potentially slight relevance of such documents, combined with the likely duplicative nature of the production from the Licensees, the Court sees no reason to impose any burden on the Licensees with respect to the production of such documents.

On the other hand, Defendants have provided the Court with sufficient reason to believe that production by the Licensees of "communications" relating to their license agreements with Plaintiffs, or communications relating to LimeWire, may contain additional relevant material, beyond that produced by Plaintiffs, outweighing the potential burden to the Licensees. *See Viacom Intern., Inc. v. YouTube, Inc.*, 2008 WL 3876142, 3 (N.D. Cal. 2008) ("[I]n appropriate circumstances, production from a third party will be compelled in the face of an argument that the 'same' documents could be obtained from a party, because there is reason to believe that the files of the third party may contain different versions of documents, additional material, or perhaps, significant omissions.") (internal quotation omitted). With respect to the Licensees' internal communications, although the *Licensees'* attitude and conduct towards Defendants are not relevant, such communications may reflect *Plaintiffs'* attitude and conduct towards online licensing and/or towards Defendants, and would be relevant to that extent.

Accordingly, the Licensees need not produce their license agreements with Plaintiffs or records of payments made to Plaintiffs under those agreements. The Licensees should, however, produce copies of their communications with Plaintiffs, as well as their internal communications, regarding those license agreements and/or LimeWire, to the extent such communications reflect information regarding Plaintiffs' conduct, Plaintiffs' stated positions, or Plaintiffs' views regarding online licensing arrangements in general, or regarding LimeWire in particular.[3]

Finally, as to the time frame covered by Defendants' subpoenas, the Court understands that certain of the Licensees already produced documents in response to one or more subpoenas served by Defendants earlier in this litigation, apparently during the initial phase of discovery in this case. Defendants are not entitled to discovery that they could and should have obtained during the initial phase of this litigation. Defendants are, however, entitled to discovery relating to the period subsequent to April 18, 2008 (the close of the initial phase of discovery), or, to the extent a Licensee produced documents pursuant to an earlier subpoena, for the period subsequent to the date of that prior production.

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[3] The Court declines to require the Licensees to use the same electronic search terms as were used by VEVO to locate these types of communications. To the extent the VEVO Order specified certain search terms that were to be used to locate documents responsive to the subpoena that was then at issue, the Court notes that its VEVO Order essentially found reasonable, and thus formalized, a final offer made by VEVO – a joint venture of two Plaintiffs – after it had engaged in extensive negotiations with Defendants. While the Licensees may wish to take guidance from the Court's prior Order, they should, in the end, use their own judgment as to the best means of locating the communications covered by this Order.

III. COST OF PRODUCTION

Google, in particular, requests that Defendants bear the cost of any production of documents ordered by the Court. Under Rule 45 of the Federal Rules of Civil Procedure, an order on a motion to compel "must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance." Fed. R. Civ. P. 45(c)(2)(B)(ii). The Court has modified the scope of the requested discovery and has thereby reduced the burden on Google. Further, as noted above, Google has not made any specific, supported showing as to the cost of production. Accordingly, Google's request to shift costs is denied. *See JP Morgan Chase Bank v. Winnick*, No. 03 Civ. 8535 (GEL), 2006 WL 3164241, at *2 (S.D.N.Y. Nov. 2, 2006) (declining to shift costs of production from a non-party because, *inter alia*, the burden imposed would not be significant for an entity of that type).

CONCLUSION

For the foregoing reasons, iMesh and MySpace's motions for sanctions are denied; Google's motion to shift costs is denied; and it is hereby ORDERED that, to the extent they have not already done so, the Licensees shall produce, for the period described above, any communications, both internal and with Plaintiffs, relating to their licenses with Plaintiffs and/or relating to LimeWire, to the extent those communications reflect information regarding Plaintiffs' conduct, positions, or views about online licensing or about LimeWire. Defendants' applications are denied in all other respects.

Dated: New York, New York
January 31, 2011

SO ORDERED

DEBRA FREEMAN
United States Magistrate Judge

Copies to:

Hon. Kimba M. Wood

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